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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Yves Gagnet

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EXAMINER

GOLIGHTLY, ERIC WAYNE

ART UNIT

PAPER NUMBER

1714

MAIL DATE

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09/01/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/571,738	<b>Applicant(s)</b> GAINET ET AL.	
	<b>Examiner</b> Eric Golightly	<b>Art Unit</b> 1714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-12 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) 5,15,16,18 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-12 and 14-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02 July 2010</u> .                                            | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 7/2/2010 has been entered.

2. Claims 1-6, 8-12 and 14-22 are pending. Claims 5, 15, 16, 18 and 20 are withdrawn. Claims 7 and 13 are canceled. Claim 22 is new.

### ***Information Disclosure Statement***

3. The information disclosure statement filed 7/2/2010 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Specifically, there does not appear to be such concise explanations for JP 393761, JP 46673 and JP 06015744. It has been placed in the application file, but the information referred to therein has not been considered.

***Claim Objections***

4. Claims 1 and 19 are objected to because of the following informalities:

Further regarding claim 1, a comma immediately following the phrase "to clean" bridging lines 9 was deleted but was not shown by strike-through or double brackets. MPEP 714(C)(2).

Regarding claim 19, the first occurrence of the word "filtration" in line 4 is shown by underlining, but was not newly added. MPEP 714(C)(2).

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6-11, 14, 17, 19, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,780,197 to Schuman (hereinafter "Schuman").

Regarding claim 1, Schuman teaches a module (abstract), which is fully capable of being disposed of, is fully capable of being used for pretreatment, e.g., by using subsequent treatment means (Fig. 2, ref. 84 and col. 6, lines 44 and 45 upstream of Fig. 2, especially ref. 72, 68, 78 and col. 5, lines 19-25), the module comprising a purification pretreatment means (Fig. 2, ref. 56 and col. 4, line 19) and a housing (Fig. 2, ref. 24, including ref. 28 and 94 and col. 3, line 33, 34, and 44 and col. 5, line 48) in which the

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purification means are housed, and wherein the housing contains from the outset a cleaning agent (Fig. 2, ref. 104 and col. 5, line 61) disposed to be fully capable of coming in contact with a fluid caused to circulate inside the housing after a cleaning cycle has been started.

Regarding claim 2, the module as per the Schuman teaching is fully capable of not being demounted.

Regarding claim 3, Schuman discloses a module wherein the cleaning agent is disclosed between the purification pretreatment means and a purified fluid outlet formed in the housing (Fig. 2, ref. 44 and col. 4, lines 30 and 31).

Regarding claim 4, Schuman discloses a module wherein the cleaning agent is housed in a space (Fig. 2, ref. 94 and col. 5, line 48) in the housing.

Regarding claim 8, Schuman discloses a module wherein the purification pretreatment means comprises a front filtration member (Fig. 2, ref. 84).

Regarding claim 9, Schuman discloses a module wherein the cleaning agent comprises a chemical compound and is capable of having a bactericidal effect (col. 5, line 61).

Regarding claim 10, Schuman discloses a module wherein the cleaning agent is in a form of tablets (col. 5, line 61).

Regarding claim 11, Schuman discloses a module wherein the cleaning agent is a chlorinated product (col. 5, lines 61, 67 and 68).

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Regarding claim 14, initially it is noted that the recited system requires no additional structure beyond what is taught in claim 1. Thus, Schuman discloses a system for purifying a fluid comprising the module of claim 1.

Regarding claim 17, Schuman discloses a module wherein the cleaning agent is housed in a recess (Fig. 2, area within ref. 62 and col. 4, line 26) in a raised portion of the housing.

Regarding claims 19 and 6, Schuman discloses a module wherein the cleaning agent is fully capable of being disposed at a location between a means for purifying a liquid by tangential filtration and a fluid outlet formed in the housing (Fig. 2, ref. 44 and col. 4, lines 30 and 31). It is noted that the tangential filtration means also reads on a purification treatment module. It is noted that reverse osmosis, nanofiltration, ultrafiltration and microfiltration are known in the art.

Regarding claims 21 and 22, Shuman discloses a module wherein the cleaning agent is disposed such that it is fully capable of coming into contact with a fluid caused to circulate inside the housing to clean at least a portion of a purification system which is downstream of the pretreatment module wherein the fluid is water (abstract).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. The common knowledge or known in the art statements made in the previous Office actions are taken to be admitted prior art because applicants failed to traverse the examiner's assertion of official notice. MPEP 2144.03(C).

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schuman (US 4,780,197).

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Schuman discloses a module wherein the cleaning agent comprises chlorine (col. 5, lines 61-68), but does not explicitly teach the agent comprises one the recited list of substances, which includes bleach. Bleach is known in the art and the skilled artisan would have found it obvious to use an agent comprising bleach in the module of the Schuman teaching to, e.g., kill bacteria, with a reasonable expectation of success.

### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 4,944,875 to Gagnet (hereinafter “875”), which teaches a device for producing pure water. Although the conflicting claims are not identical, they are not patentably distinct from each other



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because the claims of '875 differ from those of claim 1 of the present invention in that the claims of '875 do not explicitly teach the cleaning agent. Cleaning agents are known in the art and the skilled artisan would find it obvious to include a cleaning agent in order to enhance the fluid purification with a reasonable expectation of success.

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### ***Response to Amendment***

14. The following is in response to the submission filed on 7/2/2010. The objections to the specification and claims made in the prior Office action are withdrawn in view of the amendment. New claim objections are raised herein as discussed in the sections "Claim Objections".

### ***Response to Arguments***

15. Applicants' arguments in the submission filed 7/2/2010 have been fully considered but they are not persuasive.

Regarding applicants' assertion that a copy of an English translation of a JPO office action in a corresponding Japanese application complies with the 37 CFR 1.98(a)(3) requirement of a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language since, it is alleged, the JPO office action mentions those non-English patents and that the relevance should be apparent (remarks at page 7, last full paragraph)., it is noted that, while it is apparent that those references may be relevant, this is not a concise

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explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed. It is not apparent, from this JPO office action, how this individual understands each patent listed to be relevant. Indeed, one of the listed patents, JP 06015744 is merely listed as a cited reference in the JPO office action with no further elaboration.

Applicants argue that the applied art teaches away from a cleaning agent placed at the outset inside the pretreatment disposable module, wherein the cleaning agent is intended to be used to clean a portion of the purification system downstream of the pretreatment module following starting a system cleaning procedure since, it is alleged, Schuman (US 4,780,197) a chlorinator assembly inside a filter element, which chlorinator assembly is intended to be used to clean fluid circulating through the assembly (remarks at page 12, first paragraph). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, Schuman discloses a housing (Fig. 2, ref. 24, including ref. 28 and 94 and col. 3, line 33, 34, and 44 and col. 5, line 48) that contains from the outset a cleaning agent (Fig. 2, ref. 104 and col. 5, line 61), that is, the cleaning agent is in the housing from the beginning, and the cleaning agent is fully capable of being used to clean a portion of a purification system (which is not claimed) downstream of the pretreatment module following after a cleaning cycle has been starter since Schuman discloses a

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cleaning agent comprising chlorine which will continue to disinfect, or clean, downstream of the module.

Applicants' assert that the prior Office action included conclusory statements that claim 12 was obvious in view of the applied art coupled with the knowledge of the skilled artisan since, it is alleged, the Office action failed to provide a rational basis for arriving at the conclusion (remarks at page 13, first full paragraph). It is noted that the prior Office action did not make the conclusory statement that claim 12 was obvious by merely stating this was so. Rather, the Office action put forth that the claimed features would have been obvious in view of the applied art and the knowledge of the skilled artisan with a reasonable expectation of success, which is a rational basis. Indeed the Office action pointed out that this had been put forth in an even earlier Office action (see the Office action mailed 9/15/2009 at page 14, first and second paragraphs).

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Golightly whose telephone number is (571) 270-3715. The examiner can normally be reached on Monday to Thursday, 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Kornakov can be reached on (571) 272-1303. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EWG

/Michael Kornakov/

Supervisory Patent Examiner, Art Unit 1714